

REMARKS

Claims 1-37

Claims 1-37 have been rejected under 35 USC 103(a) as being unpatentable over Sheldon et al. (US6072486) in view of De Angelo (US7010536), and in yet further view of Sheinkman et al. (US5848424).

The analysis of obviousness was set forth in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966). In order to establish a *prima facie* case of obviousness, three basic criteria must be met:

First, there must be some *suggestion or motivation*, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the teachings of the references. Second, there must be a *reasonable expectation of success*. Finally, the prior art reference or combined references must teach or suggest *all the claim limitations*. *The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art*, and not based on applicant's disclosure (*In re Faeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991; emphasis added).

Applicants respectfully traverse the rejection as failing the *Graham* test. Specifically, the combination proposed in the rejection fails at least the first and third elements of the *Graham* test.

Regarding claims 1, 10 and 19, the rejection fails at least the third element of the *Graham* test. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Claims 1, 10 and 19 each require linking the toolbar to a portal, wherein the portal is for aggregating content selected by the user. The rejection relies on Sheldon's Figs. 18-20 and the "links toolbar" of col. 17, lines 37-43 to disclose this feature. However, Applicants note that Figs. 18-20 do not show a portal of a user, nor content aggregated by the user. Rather, Figs. 18-20 appear to merely show a web browser, and user manipulation of the deskbar itself, not content. Nowhere do these Figures teach or suggest that the deskbar is linked to a portal of the user, where the portal is for aggregating content selected by the user.

A review of col. 17, lines 37-43 revealed no teaching or suggestion that the deskbar is linked

to a portal of the user, where the portal is for aggregating content selected by the user.

Similarly, upon review of the “links bar” in Sheldon, it does not appear that the user is allowed to add links to the link bar. Rather, it appears that the links are fixed. Accordingly, the link bar fails to teach or suggest that the deskbar is linked to a portal of the user, where the portal is for aggregating content selected by the user.

Also, the rejection relies on Sheinkman’s target to show a bucket that could be implemented on a toolbar. However, Sheinkman’s target is not a tool which assists a user to aggregate content, as conceded in the rejection. The rejection further relies on De Angelo’s system to show drag and drop capabilities. However, De Angelo requires use of the container editor screen of De Angelo Fig. 14 to allow dragging and dropping content. Nowhere does De Angelo teach or suggest that his system could be linked to a target on a toolbar over a website. Nor is there any enablement for such a proposition. Accordingly, Applicants respectfully disagree that the combination of art teaches each and every limitation of claims 1, 10 and 19.

For any of the foregoing reasons, the rejection fails the third prong of the Graham test, as the prior art of record fails to teach or suggest the claimed limitation of linking the deskbar to a portal of the user, where the portal is for aggregating content selected by the user.

Applicants also believe that the rejection of claims 1, 10 and 19 fails the first prong of the *Graham* test.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Although a prior art device “may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.” 916 F.2d at 682, 16 USPQ2d at 1432.).

In the instant case, the rejection indicates that it would have been obvious to modify Sheldon’s deskbar to include a drop target of Sheinkman, the motivation being for the advantage of relating web locations without creating a pointing link from one to the other. Applicants respectfully disagree with that motivation. The rejection relies in part on Sheldon showing a “links bar”, while the motivation to add Sheinkman’s target is the ability to relate web locations without creating a pointing link from one to the other. The motivation seems to be at odds with the teachings purported to show the claimed elements. Accordingly, the motivation appears to be

erroneous, thus causing the rejection to fail the first prong of the *Graham* test.

Further, the rejection proposed would require an impermissible change in the principle of operation of Sheldon. Particularly, the rejection indicates that it is Sheldon's link toolbar that meets the claim limitations. However, the purpose of Sheinkman's drop target is to eliminate reliance on pointing links. To add Sheinkman's drop target would defeat the principle of operation of Densen's links toolbar, which operates solely on the principle of pointing links. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)

Claims 2-9 depend from claim 1, and therefore incorporate the limitations of claim 1. By virtue of their dependence, claims 2-9 are also believed to be allowable. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Reconsideration and allowance of claims 2-5 is respectfully requested.

Claims 11-18 depend from claim 10, and therefore incorporate the limitations of claim 10. By virtue of their dependence, claims 11-18 are also believed to be allowable.

Additionally, regarding claims 2 and 11, Applicants respectfully disagree that the proposed combination of art teaches or suggests that the toolbar include a sign on button. This feature is not even mentioned in the rejection. Accordingly, the rejection fails the third prong of the *Graham* test.

Further, regarding claims 2 and 11, the rejection relies on official notice. Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be "capable of such instant and unquestionable demonstration as to defy dispute" (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)). It is never appropriate to rely solely on "common knowledge" in the art without evidentiary support in

the record, as the principal evidence upon which a rejection was based. *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697.

Claims 2 and 11 require that the toolbar include a sign on button, where the toolbar links to a portal upon the user signing in. Applicants submit that, at the time the present invention was made, toolbars linking to portals, much less after a user signs in, were not notorious and well known, and perhaps even nonexistent absent Applicants' disclosure. Accordingly, claims 2 and 12 are distinguishable from the art of record, and the Official Notice does not apply to the limitations of claims 2 and 11.

If a future rejection of claims 2 and 11 relies on Official Notice, Applicants request a specific showing of a toolbar having a sign on button where the toolbar links to the portal upon the user signing in, and having each and every claimed feature, and further that predates Applicants' date of invention.

Regarding claims 4 and 13, Applicants respectfully disagree that the proposed combination of art teaches or suggests that the toolbar include a headlines button. The section of De Angelo cited in the rejection merely points to the description of the drawings, and nowhere implies that any content can be placed in a container. And even if De Angelo did suggest that any content could be included in a container, there is no teaching in any of the references for a headlines button, where headlines of the portal are displayed on the web browser upon selection of the headlines button. No showing has been made that De Angelo is capable of generating such headlines for display, much less that a new button displaying such headlines could be added to Sheldon. Accordingly, the rejection fails the third prong of the *Graham* test.

Regarding claims 8 and 17, Applicants respectfully disagree that the proposed combination of art teaches or suggests a toolbar having a search field. The rejection points to Sheldon col. 1, lines 1-8. However, a review of this section revealed no discussion of searching. Applicants did note that Sheldon Figs. 18-20B include a search button. However, no description of a search field on the toolbar was found. Accordingly, the rejection fails the third prong of the *Graham* test.

Claims 20, 28, 36 and 37 contain limitations similar to claims 1, 10, and 19, respectively. Therefore, the rejection of claims 20, 28, 36 and 37 suffer from the same deficiencies as the rejection of claims 1, 10 and 19.

Further, regarding claims 20, 28, 36 and 37, Applicants respectfully disagree that the proposed combination of art teaches or suggests a toolbar that includes a sign on button. This feature is not even mentioned in the rejection. Accordingly, the rejection fails the third prong of the *Graham* test.

Further, regarding claims 20, 28, 36 and 37, the rejection relies on official notice. Applicants again challenge the taking of official notice. Claims 20, 28, 36 and 37 require that the toolbar include a sign on button, where the toolbar links to a portal upon the user signing in. Applicants submit that, at the time the present invention was made, toolbars linking to portals, much less after a user signs in, were not notorious and well known, and perhaps even nonexistent absent Applicants' disclosure. Accordingly, claims 20, 28, 36 and 37 are distinguishable from the art of record, and the Official Notice does not apply to the limitations of claims 20, 28, 36 and 37.

If a future rejection of claims 20, 28, 36 and 37 relies on Official Notice, Applicants request a specific showing of a toolbar having a sign on button where the toolbar links to the portal upon the user signing in, and having each and every claimed feature, and further that predates Applicants' date of invention.

Claims 21-27 depend from claim 20, and therefore incorporate the limitations of claim 20. By virtue of their dependence, claims 21-27 are also believed to be allowable.

Claims 29-35 depend from claim 28, and therefore incorporate the limitations of claim 28. By virtue of their dependence, claims 29-35 are also believed to be allowable.

Additionally, regarding claims 22 and 30, Applicants believe that the rejection is erroneous for the same reasons as set forth above in the discussion of claim 4.

Additionally, regarding claims 26 and 34, Applicants believe that the rejection is erroneous for the same reasons as set forth above in the discussion of claim 8.

In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 971-2573. For payment of any additional fees due in connection with the filing of this paper, the Commissioner is authorized to charge such fees to Deposit Account No. 50-1351 (Order No. NVIDP380).

Respectfully submitted,

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